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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,284	03/21/2001	Binnur Al-Kazily	10004463-1	3952

7590 03/28/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,284

Applicant(s)

AL-KAZILY ET AL.

Examiner

King Y. Poon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of group I (claims 1-10, 15-17) in the reply filed on 11/8/2004 is acknowledged.
2. Claims 11-14, 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/8/2004.

Claim Objections

3. Claim 1 is objected to because of the following informalities: appliance of line 1 is being misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 6, 7, 9, 10, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolff (US 6,738,841).

Regarding claim 1: Wolff teaches a method performed on an information appliance (PDA, column 8, line 48) for printing a document (column 8, line 56) stored on a remote computer (server 920, column 9, lines 8-10), the method comprising: providing a connection between an information appliance and a remote computer (fig. 9), wherein the remote computer stores one or more documents, receiving synchronization information (the information that causes fig. 10 to be displayed) from the remote computer, the synchronization information comprising one or more reference information, wherein each reference information identifying a document (fig. 10, identifying document 1000 identifying contract 1100 being stored in the server 920, column 9, lines 5-15, column 8, lines 65-67) stored on the remote computer, displaying the reference information (fig. 10) on an information appliance display; receiving a selection of one or more documents from the displayed reference information (the PDA must receive a selection from the user in order for the user to request printing the document using the PDA); receiving a command (the signal generated by the user's action of selecting, e.g., the electric signal generated by touching a key) to print the one or more selected documents, and responsive to receiving the command (inherently, all PDA response to command/signal generated by user's action) to print, transmitting a print request (column 9, lines 8-10 and quote 1000, column 8, lines 65-67) to a nearby printer (since it is wireless, column 8, line 49, the PDA can inherently move around; therefore, the printer of Wolff is nearby when the user is walking close to the printer or far away when the user is far away from the printer).

Regarding claim 2: Wolff teaches wherein the print request is transmitted over a wireless connection (column 8, line 49) between the information appliance and the nearby printer.

Regarding claim 6: Wolff teaches wherein the print request comprises one or more references identifying the one or more selected documents (inherent properties of the print request if the print request is able to control the printer driver 255 to retrieve the document from a document server, column 9, lines 5-20).

Regarding claim 7: Wolff teaches wherein the print request comprises an user identification information (Ogawa, fig. 10, column 8, lines 65-68, the examiner view quote 1000 as part of a print request).

Regarding claim 9: Wolff teaches wherein the information appliance is a wireless phone (column 8, line 44).

Regarding claim 10: Wolff teaches wherein the information appliance is a personal digital assistant (column 8, line 44).

Regarding claims 15, 16: Inherently all PDA are controlled by software and requires a computer readable storage medium having stored computer instruction. Please also see discussion of claims 1, and 7.

Regarding claim 17: Wolff teaches wherein the print request comprises identification information for the remote computer (location, fig. 10; the document is located on the server; furthermore Wolff teaches printer accessing server using WWW, column 4, lines 55-60, inherently identification of the server is required in order for the printer to access the server from WWW).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6,738,841) as applied to claims 1, 2 above, and further in view of Dalton (US 6,246,211).

Regarding claim 3: Wolff does not teach wherein the wireless connection conforms to the Bluetooth technology.

Dalton, in the same area of wireless communication, teaches it is well known in the art that a PDA communicates with other devices using Bluetooth technology (column 4 lines 10-15).

Since Wolff does not teach the kind of technology that is used in the wireless communication and without a communication protocol/technology, wireless communication does not work; a person with ordinary skill in the art must rely on other teaching/references in order to make use of Wolff.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have used Bluetooth technology for the wireless communication such that the PDA can be able to communicate and using a well

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establish protocol for communication would ensure the PDA of Wolff can be widely used.

8. Claims 4, 5, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6,738,841) as applied to claim 1 above, and further in view of Eldridge et al (US 6,430,601).

Regarding claims 4, 8: Wolff does not teach wherein the one or more documents are stored in a mailbox and serve by a mail box server, wherein the mailbox is associated with a user.

Eldridge, in the same area of accessing document from a mobile device (118, fig. 1) from document server (column 3, lines 30-35, fig. 1), teaches wherein the one or more documents accessed by a mobile device are stored in a mailbox (column 6, lines 60-63, column 7, lines 25-30, column 7, lines 45-50), wherein the mailbox is associated with a user.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff to include: wherein the one or more documents are stored in a mailbox and serve by a mail box server, wherein the mailbox is associated with a user.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff because of the following reasons: (a) email is the most convenient and most widely used by users all over the world way of sending documents; and (b) it would have allowed users to communicate with other

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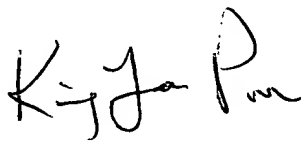
users and printing document, images and pictures send from other users located everywhere in the world.

Regarding claim 5: Please see discussion of claim 4.

Wolff teaches wherein the print request comprises the mailbox server's identification information (location, fig. 10; the document is located on the mailbox server after the modification by Eldridge; furthermore Wolff teaches printer accessing server using WWW, column 4, lines 55-60, inherently identification of the server is required in order for the printer to access the server from WWW).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (571) 272-7440.

A handwritten signature in black ink, appearing to read 'King Y. Poon', is written above the printed name.

**KING Y. POON
PRIMARY EXAMINER**

3/17/05